

REMARKS

Claims 1-36 and 43-60 are active and subject to restriction. There was a duplicate claim number 23, one of which has been renumbered as claim 24. Claims 3, 7, 14, 21, 23, 24, 33, 43, 44, 55 and 56 have been amended, without prejudice, in the interest of clarity and consistency. No new matter has been added.

ELECTION/RESTRICTIONS

Restriction has been required to one of the following inventions:

- I. Claims 1-19, drawn to a magnetically actuated system.
- II. Claims 20 and 55, drawn to a magnetic sensor.
- III. Claims 21-36 and 56-60, drawn to a support assembly for a magnetic actuator.
- IV. Claims 43-55, drawn to an actuator for controlling movement of a permanent magnet.

The Examiner asserts that the inventions are distinct from each other because the inventions of Group I and Groups II-IV are related as subcombinations disclosed as usable together in a single combination. The Examiner also asserts that the subcombinations are distinct from each other because each invention has separate utility, independent of the other inventions, in accordance with MPEP § 806.05(d). In addition, Applicant is required to elect a single species with respect to the asserted Embodiments 1-13.

Applicant elects the claims of Group I, with traverse, for immediate prosecution. Applicant reserves the right to file divisional applications for the remaining inventions of Groups II-IV, if necessary.

Applicant respectfully traverses the restriction requirement on the ground that the selection and description of the claims allocated to Groups I-IV is in error. In particular, as to Group I, claims 1-19 are not drawn to a magnetically actuated system as set forth in the Office Action. Rather, as set forth in the preamble, independent claims 1 (upon which claims 2-13 depend) and 14 (upon which claims 15-19 depend) are directed to a magnetically actuated apparatus, not a magnetically actuated system.

As to the invention of Group II, claims 20 and 55 are not drawn to a magnetic sensor. Rather, Claim 20 is directed to a magnetically operated apparatus as set forth in the preamble of that claim. Claim 55 is directed to a magnetically actuated switching device as set forth in the preamble of that particular claim. Accordingly, given the preamble of each of these claims, it is unclear why they are described as being directed to a magnetic sensor. It is the combination of claimed elements that may be subject to restriction, not specific claim elements of a combination. Selection of elements of a claim for purposes of restriction is contrary to the MPEP. Applicant submits that the claims of Groups I and II should not be grouped separately, but are one Group.

As to the invention of Group III, claims 21-36 and 56-60 are not drawn to a support assembly for a magnetic actuator. As set forth in the preamble, independent claims 21 (upon which claims 22-36 depend) and 56 (upon which claims 57-60 depend) are directed to a magnetically actuated apparatus, similar to the claims of Group I. It is unclear why it was concluded that the claims are drawn to a support assembly. In any event, all of the claims of Groups I, II and III should be combined as one Group because they relate to similar subject matter, namely a magnetically actuated apparatus or switch which, effectively, is an apparatus.

As to the inventions of Group IV, claims 43-55 are not drawn to an actuator for controlling movement of a permanent magnet. First, as set forth in the preamble, independent claim 43 is directed to a magnetically actuated apparatus, similar to the claims of Groups I and III. Second, as set forth in the preamble, independent claim 44, upon which claims 45-53 depend, are directed to an adjustable magnetic switch, which is effectively one kind of apparatus and thus not different in kind, but degree from the claims directed to an apparatus. Third, claim 54 is a method claim for providing a magnetically actuated apparatus, which is similar to the subject matter of the claims discussed above. Fourth, claim 55, amended, to which the Examiner previously assigned to the inventions of Group II, is directed to a magnetically actuated switch which should be grouped with claim 44 in Group I, as discussed above.

Accordingly, Applicant respectfully submits that restriction as to Groups I-IV should be withdrawn because the claims have been improperly grouped together.

Furthermore, all of the claims of Group I-IV relate to the same subject matter of being directed to a magnetically actuatable, actuated or operated apparatus or switch, which is effectively an apparatus. All of the claims fall within the same class 335 (magnetically operated switches, magnets and electromagnets) and/or subclass 205 (permanent magnet actuated switches), even as the Examiner has identified in the Office Action. Accordingly, there will be no additional burden on the Examiner in examining all of the claims. Indeed, MPEP § 803 mandates that, even if the restriction is proper, if there is no additional burden on the Examiner in examining all of the claims, all claims must be examined.

Applicant also traverses the conclusion that each of the inventions of Groups 1-IV are subcombinations on the ground that the conclusion was based upon an incorrect reading of the subject matter covered by the claims, as set forth above. For these reasons, the Examiner's assertion that inventions of Group I and II-IV are related as subcombinations pursuant to MPEP § 806.05(d) is incorrect and should be withdrawn.

Accordingly, Applicant respectfully submits that the Examiner's restriction requirement should be withdrawn and all claims examined on the merits.

ELECTION OF SPECIES

Restriction has been required to one of the following alleged species of the invention:

Embodiment 1:	figure 10;
Embodiment 2:	figure 11;
Embodiment 3:	figure 11A;
Embodiment 4:	figure 32;
Embodiment 5:	figure 33;
Embodiment 6:	figure 34;
Embodiment 7:	figure 34A;
Embodiment 8:	figure 35;
Embodiment 9:	figure 35a;
Embodiment 10:	figure 36;
Embodiment 11:	figure 36A;
Embodiment 12:	figure 37; and

Embodiment 13: figure 37A.

Applicant hereby elects Embodiment 1 (Figure 10), with traverse, for immediate prosecution. Applicant reserves the right to file divisional applications for the remaining species, if necessary. Applicant notes that a review of the specification and drawings has not revealed a Figure 34A.

The Examiner did not discuss Figures 9, 9A and 12-31 or group them with a particular species. Applicant submits that Figures 9, 9A and 12-31 should be grouped with Embodiment 1 (Figure 10). When Embodiment 1 (Figure 10) is properly grouped with Figures 9, 9A and 12-31, claims 1-33, and 43-60 read on those embodiments.

The Examiner did not regard any claim as being generic. Applicant respectfully disagrees. Claims 1, 14, 20, 21, 43, 44, 54, and 55 are generic to Embodiment 1 (Figure 10) and Figures 9, 9A and 12-31 that should be properly included in Embodiment 1. In addition, Embodiment 2 (Figures 11 and 11A) and Embodiments 4-13 are not necessarily separate species. As presented in the specification, Figures 11 and 11A (discussed on page 35, line 17 to page 37, line 6) and Figures 32 to 37A (discussed on page 55, line 18 to page 56, line 15) show alternative embodiments of the multiple, aligned alike magnetic fields, which is an element of the magnetically actuated, actuatable or operated apparatus that is being as claimed. Therefore, Figures 11, 11A and Figures 32-37A should not be regarded as separate species and, for those reasons, should not be separately classified. Furthermore, a review of the various figures designated as different species shows that each depict implementations employing multiple, aligned alike magnetic fields, which is a new direction in the art. To this extent, it is not seen how the


various depictions of such magnet fields gives rise to different species for purposes of restriction among different figures.

Since the above listed claims are believed generic and allowable, all of the claims in the present application must be considered upon allowance of the generic claims, which encompass all of the species identified by the Examiner. MPEP § 806.04(d).


For the above reasons, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement. Applicant submits that the application is in condition for allowance and, thus, a notice of allowance is respectfully solicited.

A request for a one-month extension of time is enclosed with this response.

Authorization is hereby provided to charge the \$60.00 extension fee, any necessary additional fees or credit any overpayment to Deposit Account No. 03-0678. Applicant is a small entity.

FACSIMILE CERTIFICATE	
Facsimile Date: January 16, 2006	
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 G. Glennon Troublefield	<u>Jan. 16, 2006</u> Date

Respectfully submitted,
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